



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

09/881,475

06/14/2001

H. Ralph Snodgrass

441472000400

7883

25226

7590

09/20/2002

MORRISON & FOERSTER LLP
755 PAGE MILL RD
PALO ALTO, CA 94304-1018

EXAMINER

SULLIVAN, DANIEL M

ART UNIT

PAPER NUMBER

1636

8

DATE MAILED: 09/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/881,475

Applicant(s)

SNODGRASS

Examiner

Daniel Sullivan

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-41 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

DETAILED ACTION

Claims 1-41 are pending in the instant application. IDS filed in papers #4 (filed 10/01/01) and #5 (filed 03/05/2002) have been entered.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, 10-18, 21-33, drawn to a method of creating a molecular profile of a chemical composition by nucleotide hybridization assay, classified in class 435, subclass 6.
- II. Claims 1-4, 7, 8, 10-18, 21-33, drawn to a method of creating a molecular profile of a chemical composition by immunoassay, classified in class 435, subclass 7.1+.
- III. Claims 1-4, 7, 9-18, 21-33, drawn to a method of creating a molecular profile of a chemical composition by mass spectrometry, classified in class 250, subclass 281+.
- IV. Claims 19, 20, drawn to a library of profiles wherein the profiles are nucleotide hybridization patterns, classified in class 435, subclass 6.
- V. Claims 19, 20, drawn to a library of profiles wherein the profiles are protein profiles generated by immunoassay, classified in class 435, subclass 7.1+.
- VI. Claims 19, 20, drawn to a library of profiles wherein the profiles are protein profiles generated by mass spectrometry, classified in class 250, subclass 281+.

VII. Claims 34-41, drawn to an integrated system comprising an array reader, classified in class 425, subclass 288.1+.

Claims 1-4, 10-18, 21-33 embrace the inventions of Groups I-III. Should one of these Groups be elected, claims 1-4, 10-18, 21-33 will be examined only to the extent they encompass the elected subject matter.

Claim 7 embraces the inventions of Groups II-III. Should one of these Groups be elected, claim 7 will be examined only to the extent it encompasses the elected subject matter.

Claims 19, 20 embrace the inventions of Groups IV-VI. Should one of these Groups be elected, claims 19, 20 will be examined only to the extent they encompass the elected subject matter.

The inventions are distinct, each from the other because of the following reasons:

The Inventions of Groups I-III involve different materials and method steps and are thus distinct from one another. Groups IV-VI are directed to libraries of profiles which are different from the methods of Groups I-III. Specifically, any of the methods of Groups I-III can be used to generate any of various combinations of profiles of any of the Groups IV-VI.

Group VII is directed to an apparatus, which is distinct from I-VI. In particular, the apparatus of Group VII can be used in any of the methods of Groups I-III and is not specially adapted for any one method.

Further, the libraries of profiles of Groups IV-VI are distinct from one another because the patterns of profiles are different for each group.

Art Unit: 1636

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II or III, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel M Sullivan whose telephone number is 703-305-4448. The examiner can normally be reached on Monday through Friday 8-4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Irem Yucel can be reached on 703-305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-9105 for regular communications and 703-746-9105 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Application/Control Number: 09/881,475
Art Unit: 1636

Page 5

dms
September 15, 2002



**JAMES KETTER
PRIMARY EXAMINER**